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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,366	12/01/2003	Iwao Saikatsu	032126	8101
38834 7590 07/23/2007 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036			EXAMINER RONESI, VICKEY M	
			ART UNIT 1714	PAPER NUMBER
			MAIL DATE 07/23/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/724,366

Applicant(s)

SAIKATSU ET AL.

Examiner

Vickey Ronesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The outstanding rejection is withdrawn in light of applicant's amendment filed on 5/7/2007.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. The new grounds of rejection set forth below are necessitated by applicant's amendment filed on 5/7/2007. In particular, claims 1 and 7 have been amended to state that the friction material comprises 0 % of a crosslinking agent for rubber and that unvulcanized rubber particles are non-self-vulcanizing. Thus, the following action is properly made final.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1 and 4-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claims 1 and 7, the term "unvulcanized non-self-vulcanizing rubber" and the phrase "wherein said non-asbestos-based frictional material comprises 0% of a crosslinking agent for rubber" fail to satisfy the written description requirement of 35 USC 112, first

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paragraph since there does not appear to be a written description requirement for non-self-vulcanizing rubber and 0% crosslinking agent in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163. Applicant has not pointed to any portion of the specification, and examiner has not found any support for this phraseology in the specification as originally filed. Note MPEP 2173.05(i) which states that “[t]he mere absence of a positive recitation is not basis for an exclusion.”

With respect to claims 4-6, they are rejected for being dependent on a rejected claim.

Claim Rejections - 35 USC § 103

5. Claims 1 and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 56-002325 (full English language translation) in view of Tabe et al (US 4,324,706) and/or Yamane (US 6,451,872).

JP 56-002325 discloses a friction material comprising a fiber such as an asbestos fiber, a glass fiber, a polyester fiber, and a polyamide fiber (i.e., fibrous base); a thermosetting resin (i.e., binder); (page 3, line 1-2); an inorganic filled substance such as barium sulfate, silica, calcium carbonate, and graphite and metal powders; and an unvulcanized rubber such as natural rubber, styrene rubber, nitrile rubber, and chloroprene rubber (page 3, lines 1-11).

Given that the amounts taught by JP 56-002325 are in parts by weight (pbw), a conversion of pbw to vol % has been estimated by the examiner. Amounts are based on the density of binder as 1 g/cm³, the density of asbestos as 2.5 g/cm³, the density of barium sulfate as 4.5 g/cm³, the density of copper powder as 8.96 g/cm³, and the density of unvulcanized nitrile rubber as 1 g/cm³. Using these densities, amounts of barium sulfate and copper powder (i.e.,

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filler) and unvulcanized nitrile rubber are calculated to be 3.4 vol % and 14.4 vol %, respectively.

While JP 56-002325 exemplifies asbestos as the fiber material, it also teaches the use of other fibers as noted above. Therefore, it is perfectly proper for the examiner to look to the whole reference for what it teaches rather than merely rely on preferred embodiments. *In re Courtright* 153 USPQ 735 (CCPA 1967).

JP 56-002325 fails to disclose silicon carbide or alumina as the inorganic filled substance and the average size of inorganic filler.

Tabe et al discloses a friction material and teaches that friction-regulating agents include those taught by JP 56-002325 such as silica, barium sulfate, and graphite and others such as silicon carbide and alumina (col. 9, lines 48-56), wherein the particles preferably have a size of 50 mesh size or smaller (i.e., < 297 microns). Yamane also discloses friction material and teaches that when silicon carbide is used as the inorganic particle, it preferably has a size of 0.1-10 microns (col. 4, lines 14-20 and 32-38).

Given that JP 56-002325 discloses the use of inorganic fillers as taught by Tabe et al and Yamane and further given that suitable inorganic fillers include silicon carbide having a particle size of 0.1-10 microns, it would have been obvious to one of ordinary skill in the art to utilize a silicon carbide as the inorganic filler in the frictional material of JP 56-002325 to obtain a desired abrasiveness.

With respect to claim 6, Yamane discloses that the size and hardness of the inorganic particles can be varied to obtain desired abrasiveness (col. 4, lines 20-31) and that mixtures of fillers can be used (col. 7, lines 31-33). Therefore, it is the examiner's position that it would

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have been well within the capabilities of one of ordinary skill in the art to utilize a mixture of silicon carbide and alumina in order to provide for a desired level of abrasiveness in the friction material of JP 56-002325.

Response to Arguments

6. Applicant's arguments have been considered but are moot in view of the new grounds of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

7/18/2007
Vickey Ronesi



/Vasu Jagannathan/
Supervisory Patent Examiner
Technology Center 1700